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| 09/291,294      | 04/14/1999  | CRIS T. PALTENGHE    | CITI0131-US         | 1910             |

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EXAMINER

NORMAN, MARC E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3744

DATE MAILED: 12/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/291,294

Applicant(s)

PALTENGHE ET AL.

Examiner

Marc E. Norman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 93 is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-12,14,19,20,22-24,34,38-41,48-50,72,73,75-81,84 and 85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1,3-5,7-12,14,19,20,22-24,28-32,34,38-41,48-50,72,73,75-81,84,85 and 93.

## **DETAILED ACTION**

### ***Response to Arguments***

In Applicant's Amendments and Remarks submitted with the Request for Continuing Examination, Applicant added claim 93 and provided remarks concerning the claim amendments and the previous claim rejections.

In the remarks regarding the claim rejections, Applicant traversed the rejections and requested reconsideration. Applicant asserted that Fischer in view of Rosen does not teach or suggest to claimed invention, and then (on pages 4 and 5) presented a general discussion each of the Fischer and Rosen references. Regarding the "Information for Executors and Administrators" reference that was also applied in the rejections, Applicant simply states that the "relevance of the article... is not apparent" (page 6, lines 3-4). Applicant then submits that the references fail to suggest Applicant's claimed invention, and then goes on to list various features recited in the claims (page 6, lines 10-18). Applicant further submits that neither Fischer nor Rosen teach allowing the owner to store data relating to the owner's estate on the local aspect of the virtual wallet application and periodically updating the remote aspect with data stored on the local aspect by a virtual archivist function of the virtual wallet application.

Each of Applicant's arguments is addressed in turn below:

- *"The relevance of the article 'Information for Executors and Administrators' is not apparent." (page 6, lines 3-4).*

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The relevance of this article has been clearly presented in the previous Office Actions. The purpose of this article is to illustrate that the concept of a bank escrowing a security device being conditioned on the occurrence of an event is old and generally well known in the financial arts. The bank securely stores data within a safety deposit box; assigns a security device to the owner for accessing the data; escrows the security device conditioned on an event; receives verification of the occurrence of the event; and accesses the data with the security device (see original Office Action, paper #6, page 3, lines 13-21). Clearly, these steps are directly related to the escrowing concepts recited in Applicant's claims. Admittedly, the reference is directed to escrowing of physical objects as opposed to computer data. Nevertheless, the fundamental concepts are the same, and certainly relevant to Applicant's invention. Motivation for applying these steps within the computerized context was also presented in the original Office Action (page 4, lines 2-6). To ignore this analysis and simply state that the reference is not relevant is not a sufficient response to the rejection.

- *The references do not teach "a virtual wallet application with local and remote aspects, a primary aspect of a secret access device for accessing both aspects, and a secondary aspect of the secret access device escrowed by a virtual executor function preprogrammed to use the secondary aspect to allow access to the owner's stored data only to an authorized representative of the owner's estate on verification of an occurrence of a predefined event that renders the owner incapable of acting on the owner's behalf." (page 6, lines 10-18)*

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As discussed above and in the original Office Action, the general concepts of primary security aspect and an escrowed secondary security aspect, as well as allowing access only to an authorized representative of the owner's estate on verification of the death of the owner, are taught by the "Information for Executors and Administrators" reference. The motivation for applying these concepts to the computerized context has also been fully addressed. The fact that Applicant applies these features within a "virtual wallet" application and using a "virtual executor function" does not in itself render the claims patentable for the reasons fully discussed in paper #9 (page 2, line 6 – page 3, line 8).

- *"Nor is there any teaching or suggestion in Fischer and/or Rosen of allowing the owner to store data relating to the owner's estate on the local aspect of the virtual wallet application and periodically updating the remote aspect of the virtual wallet application with data stored on the local aspect by a virtual archivist function of the virtual wallet application."* (page 6, lines 18-26).

The Examiner does not see any claim language (other than in new claim 93) that specifically presents this feature.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 7-12, 14, 19, 20, 22-24, 28-32, 34, 38-41, 48-50, 72, 73, 75-81, 84, and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer, Rosen and Public Legal Education of Nova Scotia (via Official Notice).

In view of the discussion provided above regarding Applicant's arguments, the previous rejections of these claims are carried forward and maintained.

***Allowable Subject Matter***

Claim 93 is allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art (and in particular the combination of Fischer, Rosen, and Public Legal Education of Nova Scotia) does not teach or render obvious a method for securely storing data for an owner wherein the following combined steps are performed: a secondary aspect of a secret access device is escrowed to allow access to the owner's stored data only to an authorized representative of the owner's estate, the owner may store data relating to the owner's estate on the local aspect, the remote aspect is periodically updated with data stored on the local aspect, and allowing access for the authorized representative to the owner's stored data utilizing the secondary aspect of the secret access device. While Public Legal Education of Nova Scotia teaches the general concepts of secure escrowing, the analogy fails to anticipate or render obvious the step, within the computerized escrowing process, of the "remote aspect being periodically updated with data stored on the local aspect by a virtual archivist function of the virtual wallet application via the network".


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc E. Norman whose telephone number is 703-305-2711. The examiner can normally be reached on Mon.-Fri., 8:00-5:30, with first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Denise Esquivel can be reached on 703-308-2597. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5648.

MN  
December 12, 2002

  
Marc Norman  
Patent Examiner  
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